

REMARKS

I. Summary of the Office Action

Claims 1-24 are all the claims pending in the application. The Examiner withdrew the previous grounds of rejection. The Examiner, however, found new grounds for rejecting the claims. Claims 1-9, 12, 13, 15, and 21-24 presently stand rejected under 35 U.S.C. § 102(e) and claims 10, 11, 14, and 16-20 are rejected under 35 U.S.C. § 103(a).

By this Amendment, Applicants hereby amend claims 1, 3, 5, and 21.

II. Prior Art Rejections

Claims 1-9, 12, 13, 15, and 21-24 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0048413 to Kusunoki (hereinafter “Kusunoki”) and claims 14 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kusunoki.

The newly found reference discloses a personal computer that obtains photo-images via scanners or from a card reader and synthesizes the obtained images (Figs. 1, 9, and 10; ¶¶ 89-106).

The Examiner contends that Kusunoki suggests each feature of independent claims 1, 3, 5, and 13. These rejections are not supportable for at least the following reasons. These independent claims *inter alia* and in some variation recite that the first image is captured by the portable device and that this portable device creates the synthesized image.

Kusunoki only discloses a conventional personal computer 12 that is connected to scanners 14 and 15, a card reader 13, a display, and a printer and that has a software application for synthesizing images (Fig. 1 and ¶ 33). However, the personal computer 12 cannot and does

not photograph an image. In addition, as is well known in the art, the personal computer 12 of Kusunoki is stationary and not portable.

With respect to dependent claims 14 and 20, the Examiner takes Official Notices that a cellular telephone can have the same computational power as the personal computer and that a personal computer may have a build-in camera to photograph images (*see* page 10 of the Office Action). These statements by the Examiner are technically inaccurate and the Official Notices are challenged.

It is noted that the personal computer disclosed in Kusunoki (Fig. 1) is a desktop computer, which is a stationary device. As is known, the personal computer has more computational power than a portable device with a build-in camera. For example, compare internet capabilities or loading time of an image in a stationary desktop computer and in a portable device such as a cell phone. In view of limited amount of resources, many image processing applications available for the stationary desktop cannot and do not run on the portable devices. Accordingly, the Examiner's Official Notice is technically incorrect and is challenged.

In addition, personal computers do not have a build-in photo camera for obvious reasons. That is, since personal computers are stationary devices, a photo camera is inefficient in that it can only photograph items within a vicinity of the personal computer which is usually hidden under a desk or in some other place. As is well known, there are no photo cameras build into the personal computers because such photo cameras would be very difficult for the user to manipulate. Accordingly, the Examiner's Official Notice is technically incorrect and is challenged. To the extent portions of a computer can include a pick up feature such a pick up apparatus will lack other processing aspects as claimed.

Applicants thus submit that in view of the limited capabilities and complexities of mobile devices, applications are especially designed for portable devices when analogous applications are provided on the stationary computers. In view of the foregoing, one of ordinary skill in the art would not have and could not have applied the synthesizing function implemented in the stationary desktop to a portable device.

In summary, the deficiencies of the Kusunoki reference fall to the Examiner's burden to show inherent inclusion or obviousness of the claim elements. Therefore, for all the above reasons, independent claims 1, 3, 5, and 13 are patentable. Claims 2, 4, 6-9, 12, 14, 15, and 20-24 are patentable at least by virtue of their dependency.

In addition, dependent claim 22 recites: "wherein the single synthesized image is transmitted to at least one of the other portable terminal apparatuses." Kusunoki does not disclose or even remotely suggest sending the image to the scanners (alleged portable terminal apparatuses) from which the image was obtained or any scanner. For at least these additional exemplary reasons, claim 22 is patentably distinguishable from Kusunoki.

Claims 10 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kusunoki in view of U.S. Patent Publication No. 2006/0125927 to Watanabe (hereinafter "Watanabe"), claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kusunoki in view of U.S. Patent Publication No. 2003/0140104 to Watanabe et al. (hereinafter "Watanabe2"), and claims 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kusunoki and Watanabe2 in view of U.S. Patent No. 6,519,048 to Tanaka (hereinafter "Tanaka"), and claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kusunoki, Watanabe and Tanaka (hereinafter "Tanaka") in view of Watanabe2. Our analysis is as follows

Claims 10-11 and 16-19 depend on claims 1 and 13, respectively. It was already demonstrated that Kusunoki does not meet all the requirements of independent claims 1 and 13. Watanabe, Watanabe2, and Tanaka fail to cure the deficient disclosure of Kusunoki. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claims 1 and 13. Since claims 10-11 and 16-19 depend on claims 1 and 13, respectively, they are patentable at least by virtue of their dependency.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Dion R. Ferguson/ #59,561

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: February 9, 2009

for Natalya Dvorson
Registration No. 56,616